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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/692,663	10/24/2003	Anjali Abhimanyu Patil	Rev 02-26	9947
7590 07/24/2007 Revlon Consumer Products Corporation Law Department 237 Park Avenue New York, NY 10017			EXAMINER MERCIER, MELISSA S	
			ART UNIT 1615	PAPER NUMBER
			MAIL DATE 07/24/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/692,663

Applicant(s)

PATIL ET AL.

Examiner

Melissa S. Mercier

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 May 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12, 15-35 is/are pending in the application.
- 4a) Of the above claim(s) 4-8 and 23-26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-3, 9-12, 15-22 and 27-35 is/are rejected.
- 7) ☐ Claim(s) 34 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Summary

Receipt of Applicants Remarks and amended claims filed on May 9, 2007 is acknowledged. Claims 1-3, 9-12, 15-22, and 27-35 are under prosecution in this application. Rejections and/or objections not reiterated from previous Office Actions are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.

Claim Objections

Claim 34 is objected to because of the following informalities: gellant is spelled incorrectly. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claim 20 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 20 provides for the use of the composition, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process

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applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 20 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Response to Arguments

Applicant's arguments have been fully considered but they are not persuasive. Applicant argues that claim 20, which depends from claim 1, is not directed to the use of the composition or a process for using the composition, but rather claim 20 further defines the composition of claim 1 as being a lipstick composition. The examiner disagrees. Claim 20 does not provide any further limitations than those of claim 1 for defining the composition and why a lipstick formulation would be any different than, for example a mascara or nail polish composition. Therefore, the form of the cosmetic composition is deemed future intended use and no given patentable weight.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-3, 9-12, 15, 17-18, 20-21, and 31-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Loginova et al. (US Patent 6,524,565).

Loginova discloses a cosmetic product for hairs and decorative cosmetic with particular water resistance and wear (transfer) resistance. The product comprises stabile mixture of a water-emulsifiable, film-forming agent; a rheology modifier; a pigment; a volatile organic solvent; an oil soluble polymeric film-former; a silicon resin; and a filler (abstract).

One embodiment of the present invention includes a water-resistant cosmetic gel, in which the film-forming agent is selected from one or more of an acrylate copolymer or acrylic or methacrylic acid or an ester thereof (column1, lines 23-30). Dimethicone and trimethylsiloxysilicate is also disclosed (column 1, lines 47-50). Isoparaffins e.g. isododecane, pentane, hexane, decane or special petroleum distillates etc. are preferably used as aliphatic hydrocarbon solvent which is not miscible with water are preferred in the stable mixture with gel structure (column 2, lines 61-66). Pigments, pigment mixtures or powders with a pigment-like effect are disclosed, including titanium dioxide, a common sunscreen agent (column 3, lines 16-18). Additional non-polar oils are disclosed as fillers (column 3, lines 32-38).

Applicant is reminded that where the general conditions of the claims are met, burden is shifted to applicant to provide a patentable distinction. Where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation. See *In re Aller*, 220 F.2d 454 105 USPQ 233,235 (CCPA 1955).

Furthermore the claims differ from the reference by reciting various concentrations of the active ingredient(s). However, the preparation of various cosmetic

compositions having various amounts of the active is within the level of skill of one having ordinary skill in the art at the time of the invention. It has also been held that the mere selection of proportions and ranges is not patentable absent a showing of criticality. See *In re Russell*, 439 F.2d 1228 169 USPQ 426(CCPA 1971).

Claims 16, 19, 22, 27-30, and 34-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Loginova et al. (US Patent 6,524,565). In view of Patel et al. (US Patent 6,342,209).

The teachings of Loginova are discussed above and applied in the same manner.

Loginova does not disclose the second film-forming polymer to be a silicone acrylic copolymer.

Patel discloses cosmetic compositions for application to skin, nails or hair, which contain one or more film forming polymers (column 1, lines 6-8). A wide variety of film forming polymers may be used in the cosmetic or personal care products of the invention. The film-forming polymer must be capable of forming a film on the skin, nails, or hair. The film forming polymers may be natural or synthetic, or a combination of both, and may be in the form of solids, semi-solids, or liquids. The film forming polymer may be neutral or ionic in character, e.g. anionic, cationic, nonionic, or amphoteric (column 2, lines 40-50). Also suitable for use as the film forming polymer in the compositions are copolymers of silicone and various organic, ethylenically unsaturated monomers, for example silicone/acrylate copolymers (column 3, lines 27-37). Additionally, synthetic polymers with the same structure as claimed in the instant claims (column 3, line 64

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through column 4, line 16). Dimethicone is disclosed as an antifoaming agent (column 6, lines 23-28). Cyclomethicone and isododecane are also disclosed as suitable oils (column 6, lines 61-68; column 7, lines 32-38). The cosmetic compositions of the invention may be in the form of pigments sticks such as lipstick, eye shadow sticks, foundation sticks, and the like. Preferably, these sticks are anhydrous (column 11, lines 38-45). Finally, Patel discloses the composition may incorporate one or more particulates, including, for example, bentonite, diatomaceous earth and montmorillonite, which are clays (column 8, lines 30-62).

It has been held that combinations of two or more compositions each of which is taught by the prior art to be useful for the same purpose in order to form a third composition which is to be used for the very same purpose. In re Susi, 58 CCPA 1074, 1079-80, 440 F.2d 442, 445, 169 USPQ 423, 426 (1971); In re Crockett, 47 CCPA 1018, 1020-21, 279 F.2d 274, 276-77, 126 USPQ 186, 188 (1960). As the court explained in Crockett, the idea of combining them flows logically from their having been individually taught in prior art. Therefore, since each of the references teaches that film forming polymers, and oils are effective ingredients in cosmetic compositions, it would have been obvious to combine these with the expectation that such a combination would be effective. Thus, combining them flows logically from their having been individually taught in prior art.

Response to Arguments

Applicant's arguments with respect to claims 1-3, 9-12, 15-22, and 27-35 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

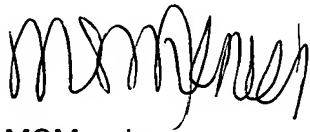
No claims are allowed. Due to the new grounds of rejection, this Office Action is made Non-Final.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melissa S. Mercier whose telephone number is (571) 272-9039. The examiner can normally be reached on 7:30am-4pm Mon through Friday.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward can be reached on (571) 272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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